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d) at least one compound comprising a phosphate, polyphosphate, polyphosphonate, nitrate or bromide; and wherein the concentrate has an amount of phosphate, polyphosphate, polyphosphonate, nitrate or bromide ranging from 0.01 to 2.5 mol/litre.

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27. The one-part bleach-fixing concentrate according to claim 13, wherein said one or more complexing agents is present in an amount from 1 to 200 mmol/l concentrate.
28. The one-part bleach-fixing concentrate according to claim 13, wherein the one or more complexing agents is in an amount of from 5 to 50 mmol/l concentrate.

See Appendix 1 for the changes. The terms underlined were added to the claims and the terms bracketed were cancelled from the claims.

REMARKS

Applicants respectfully request reconsideration in view of the amendment and following remarks. The applicants have incorporated claim 17 into claim 13. Support for newly added claim 29 can be found in claim 13. The applicants have changed the dependencies of claims 27 and 28 so that these claims do not depend upon just cancelled claim 18. No additional fee is required for the amendment.

Claims 13 through 21 and 25 through 29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Papai U.S. Patent No. 6, 221,570 (hereinafter referred to as "Papai '570") provisionally with Papai's allowed application Serial No. 09/715,612 which is the equivalent of WO 01/50196 (hereinafter referred to as "Papai '196")

considered with Meckel *et al.* U.S. Patent No. 3,293,036 (hereinafter referred to as “Meckel”), Ohkubo *et al.* U.S. Patent No. 3,591,380 (hereinafter referred to as “Ohkubo”), Williams *et al.* U.S. Patent No. 3,702,247 (hereinafter referred to as “Williams”) and Schranz *et al.* U.S. Patent No. 3,879,203 (hereinafter referred to as “Schranz”). The applicants respectfully traverse this rejection.

The priority text filed Jan. 6, 2000 in Papai ‘570 gives no hint to use phosphoric acid derivatives to stabilize a bleach-fixing concentrate. These compounds are only listed among many others as possible metal complexants on column 5, lines 21 to 46 and as acid for pH adjustment on column 8, lines 34-37 of Papai ‘570. Again, there is no suggestion to selectively choose the applicants’ claimed ingredients.

As taught by Papai ‘570, the thiocyanate salt is essential to achieve stable concentrates (see *e.g.* column 7, lines 39 to 46, column 6, lines 37 to 55 and the whole disclosure), and has to be used, although thiocyanate has severe disadvantages and even may produce toxic cyanide gas as taught on column 6, lines 28-36.

If Papai had known the preferred and in every aspect advantageous way to stabilize bleach fixing concentrates as taught by the applicants’ invention and taught in WO 01/50196, he would have disclosed it on Jan. 6th, 2000 and not on Nov. 17th, 2000. Further evidence that Papai did not recognize the applicants’ claimed combination is in WO 01/50191, which also claims priority to the January 6, 2002 earlier application (Serial Number US 09/477,565). The disclosure appears to be the same as Papai ‘570.

None of the teaching in Papai ‘196 concerning the stabilizing effect of phosphate *e.g.* page 7, lines 21 to page 8, lines 22, page 16 line 9 to page 17, lines 2 and Examples 5, 6 has been disclosed in Papai ‘570 or WO 01/50191. Papai ‘196 claims benefit to both

US 09/477,565 filed January 6, 2000 and US Serial Number 09/715,612 filed November 17, 2000. It is clear that this subject matter was added at the earliest, in the November 17, 2000 application.

Moreover on column 8, line 35 of Papai '570 and page 14, lines 24-25 of WO 01/50191 Papai states, "preferred acids have a carboxyl group, and most preferred is acetic acid", whereas on page 7, lines 21 to 22 of Papai '196 states, "one of the preferred acids is phosphoric acid".

Following these arguments it is applicants opinion, that applicants' invention was not known before May 27, 2000, which is the applicants first filing date. Even the further filings of applicants' invention as of August 03, 2000 and August 14, 2000 are prior to the November 17, 2000 date. The applicants have enclosed an English certified translation of their priority documents (see claims 1-10 and the examples, in particular claims 1 and 5 in Application no. 10039 719 filed August 14, 2000; see claims 1-7 and the examples, in particular claims 1 and 5 in Application no. 10037 765 filed August 3, 2000 and see claims 1-6, in particular claim 1 and page 3, lines 10-11 and the examples in Application no. 100 26 456 filed May 27, 2000. For the above reasons, the applicants believe that they are entitled to the effective filing date of their priority applications which antedate Papai '196.

Meckl, Ohkubo, Williams and Schranz all show ready-to-use bleach-fixing solutions but no concentrates.

It may be trivial to dilute concentrates with water to get the ready to use solution, but surely the reversed way is not trivial.

There is no hint in said disclosures, how to combine the chemicals needed for a ready-to-use bleach fixing solution in a concentrate. Before the applicants' invention, all experiments have failed to achieve a one part bleach fixing concentrate that would result in a common ready-to-use solution on dilution, because at high concentrations the chemicals normally used (reducing and oxidizing ones) react with each other and some ingredients tend to crystallize.

Surprisingly, the applicants have found, that for a concentrate as claimed, the mere addition of phosphoric acid derivatives prevents this prohibitive degradation and crystallization without any disadvantages (*e.g.* the need of problematic thiocyanate).

There is no teaching in said disclosures related to ready-to-use solutions, that phosphate would allow to produce stable concentrates.

The same argument holds for Papai '570, who teaches that the problematic thiocyanate is essential for a stable one-part concentrate (column 7, lines 39 to 41).

The concentrate of applicants' invention is the first one-part bleach fixing concentrate that makes use of phosphoric acid derivatives as stabilizer without showing any disadvantages and therefore the rejection of the claims should be withdrawn.

The Examiner must consider the references as a whole, In re Yates, 211 USPQ 1149 (CCPA 1981). The Examiner cannot selectively pick and choose from the disclosed multitude of parameters without any direction as to the particular one selection of the reference without proper motivation. The mere fact that the prior art may be modified to reflect features of the claimed invention does not make modification, and hence claimed invention, obvious unless desirability of such modification is suggested by the prior art (In re Baird, 29 USPQ 2d 1550 (CAFC 1994) and In re Fritch, 23 USPQ 2nd. 1780 (Fed.

Cir. 1992)). The applicants disagree with the Examiner why one skilled in the art with the knowledge of the references would selectively modify the references in order to arrive at the applicants' claimed invention. The Examiner's argument is clearly based on hindsight reconstruction.

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching, suggestion, or incentive supporting this combination, although it may have been obvious to try various combinations of teachings of the prior art references to achieve the applicants' claimed invention, such evidence does not establish *prima facie* case of obviousness (In re Geiger, 2 USPQ 2d. 1276 (Fed. Cir. 1987)). There would be no reason for one skilled in the art to combine Papai '570, Papai '196, Meckl, Ohkubo, Williams and Schranz. For the above reasons, this rejection should be withdrawn.

Examiner's Comment to Applicants' Response

The applicants respectfully disagree with respect to the Examiner's comments at page 4, paragraph no. 4 of the Office Action. The applicants do not recognize that Papai '570 discloses, teaches, and suggests the use of phosphoric acid as an anti-staining agent.

Furthermore, Papai '570 teaches on col. 8, lines 17-42 that an acid can be added to the concentrate. The same disclosure can be found in the applicants' description at page 3, line 26. According to Papai '570, co. 8, line 25 "practically an acid will function as an anti-staining agent".

The acid has to buffer the working bleach solution to prevent stain from carried over developer solution during processing. Phosphoric acid is listed in Papai '570 as an

example for well-known acids including organic and inorganic acids” (col. 8, lines 30-31). There is no hint from Papai ‘570 to use phosphate to stabilize the concentrate.

Moreover, the teaching of Papai ‘570 teaches away from phosphoric acid, because on col. 8, lines 36, the acids having a carboxylic group art are described to be the preferred. Again, particularly the teaching on col. 8, lines 25-30 of Papai ‘570 would have kept a person of ordinary skill in the art away from the applicants’ claimed invention, because according to the teaching of Papai ‘570, the inorganic phosphoric acid has a higher tendency to precipitate sulfur from bleach-fix concentrates than organic acids like acetic acid. It has only surprisingly been found by the applicants, that phosphate, polyphosphate, polyphosphonate, nitrate or bromide, preferably phosphate, polyphosphate and polyphosphonate, when added to a bleach fixing concentrate in an amount as presently claimed, prevent the precipitation of sulfur on storage of the concentrate.

The behavior as demonstrated, i.e. the applicants’ example 1 in comparison to sodium acetate, is opposite to the teaching of Papai ‘570 col. 8, lines 25-37 for the free acids. According to Papai ‘570, acetic acid is the most preferred, whereas the applicants have found that acetate to be unsuitable for the applicants’ invention.

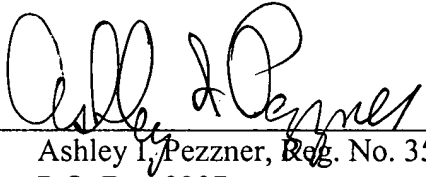
Therefore, the applicants’ claimed invention is new and unobvious over Papai ‘570. The applicants have surprisingly found the stabilizing effect (thiosulphate stability; no crystallization) of that phosphate, polyphosphate, polyphosphonate, nitrate or bromide when added to a one-part bleach-fixing concentrate in the amount as claimed. To achieve comparable results, Papai ‘570 have found the problematic thiocyanate to be essential (col. 7, lines 39-41). For the above reasons, this rejection should be withdrawn.

No additional fees are due. If there are any additional fees due in connection with the filing of this response, including any fees required for an additional extension of time under 37 CFR 1.136, such an extension is requested and the Commissioner is authorized to charge or credit any overpayment to Deposit Account No. 03-2775.

For the reasons set forth above, Applicants believe that the claims are patentable over the references cited and applied by the Examiner and a prompt and favorable action is solicited. The applicants believe that these claims are in condition for allowance, however, if the Examiner disagrees, the applicants respectfully request that the Examiner telephone the undersigned at (302) 888-6270.

Respectfully submitted,

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Enclosures: English Certified translations

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APPENDIX 1

13. A one-part photographic bleach-fixing concentrate comprising
- a) an iron(III) complex salt,
 - b) a thiosulphate,
 - c) a sulphite, a disulphite or a sulphinic acid, and
 - e) at least one compound comprising a phosphate, polyphosphate, polyphosphonate, nitrate or bromide; and

wherein the concentrate has an amount of phosphate, polyphosphate,

polyphosphonate, nitrate or bromide ranging from 0.01 to 2.5 mol/litre.

27. The one-part bleach-fixing concentrate according to claim [18] 13, wherein said one or more complexing agents is present in an amount from 1 to 200 mmol/l concentrate.
28. The one-part bleach-fixing concentrate according to claim [18] 13, wherein the one or more complexing agents is in an amount of from 5 to 50 mmol/l concentrate.